



AP/2700

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Attorney Docket No. Stahl 1

In re application of: David R. Stahl

Serial No.: 09/383,857

Group No.: 2142

Filed: 08/26/1999

Examiner: Chau T. Nguyen

Matter No.: 990.0211

Phone No.: 703-305-4639

For: Personalized Network-Based Services

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Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Dear Sir:

Enclosed herewith are an original and 2 copies of Appellant's Brief Under 37 CFR 1.192 for the above-identified patent application. A check in the amount of \$320.00 as payment of the filing fee for the Appeal Brief is also enclosed.

The Commissioner is hereby authorized to charge payment of any additional fees required under 37 CFR §§ 1.16 and 1.17 which are associated with this communication or credit any overpayment to **Mendelsohn & Associates, P.C. Deposit Account No. 50-0782.**

Respectfully submitted,

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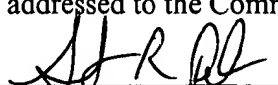

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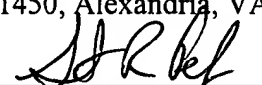
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Steven R. Petersen


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CUSTOMER NO. 22186

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PATENT

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Serial No.: 09/383,857

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APPELLANT'S BRIEF UNDER 37 CFR 1.192

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Alexandria, VA 22213-1450

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Dear Sir:

In response to the final office action of February 14, 2003, and further to the notice of appeal filed on May 12, 2003, Appellant/Applicant submits the following brief in support of the appeal:

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Steven R. Petersen

Date:

July 14, 2003

APPELLANT'S BRIEF

1. REAL PARTY IN INTEREST

The real party in interest is Lucent Technologies, Inc., assignee of all rights, title, and interest of the inventor.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

3. STATUS OF CLAIMS

Claims 1-6, 8-18, and 20-24 are pending. Claims 7 and 19 were cancelled. The appealed claims are 1-6, 8-18, and 20-24.

4. STATUS OF AMENDMENTS

An amendment after final rejection was filed on 04/21/2003 and was entered on 05/05/2003.

5. SUMMARY OF INVENTION

The invention relates to computer networks, such as the Internet, and, in particular, to receiving and storing customized sets of information from various network-based information services. (Page 1, lines 5-7.) In one embodiment, the invention is directed to a network-based service where different sets of customized information are delivered to a user at different times to different destinations (i.e., different user devices) selected by the user. (Page 2, lines 5-7.)

A user creates a user profile that includes requests for customized sets of information, and specifies a preferred format and preferred time for delivery of each set of information. (Page 5, lines 10-12.) A network-based server stores the user profile, and then at scheduled times, prepares and automatically delivers the requested sets of information to the specified user devices. (Page 5, lines 18-20.) If necessary, the server converts the format of the information

sets to the formats desired by the user, e.g., text information may be converted to an audio format via suitable text-to-audio converters. (Page 6, lines 12-14.)

6. ISSUES

This appeal presents the following issues:

A. whether an examiner may rely on a statement in a reference patent, to the effect that various modifications might be made without departing from the invention, to support a ground for rejection involving a modification of the reference patent's disclosure; and

B. whether the appealed claims are unpatentable over U.S. Patent No. 6,317,779 to Gile et al. ("Gile") in view of U.S. Patent No. 6,049,831 to Gardell et al. ("Gardell") under 35 U.S.C. § 103(a).

7. GROUPING OF CLAIMS

Appellant submits no statement regarding whether the appealed claims stand or fall together.

8. ARGUMENT

A. Procedural Background

The Examiner has rejected all claims under 35 U.S.C. § 103(a) as unpatentable over Gile in view of Gardell. This ground of rejection was initially stated in the August 27, 2002 office action. Applicant's response filed on November 27, 2002 made no substantive amendments to the claims,¹ and argued that the rejection was improper. Applicant argued that it would not have been obvious to modify Gile in the manner that would be necessary in order to form the claimed invention, because such modification would be antithetical to the purposes of the Gile system.

1. The sole amendment corrected a typographical error in dependent claim 16, changing the word "test" to "text."

Applicant also argued that Gardell cannot fairly be read as disclosing the features of the invention that are omitted in Gile. The February 14, 2003 office action repeated the Gile-in-view-of-Gardell ground of rejection, addressed Applicant's arguments, and was made final. An amendment after final rejection, submitted on April 14, 2003 for the purpose of presenting the independent claims in better form for consideration on appeal, was entered on May 5, 2003.²

B. The Stated Ground For Rejection

The Examiner stated the ground for rejecting independent claims 1 and 13 in substantially identical terms in paragraph 4 of both the August 27, 2002 and February 14, 2003 office actions. The Examiner stated that Gile discloses a method for providing information over a computer network, comprising the steps of providing a user profile, wherein the user profile defines a schedule of one or more information requests; preparing a set of information corresponding to each information request; and automatically delivering each set of information at a time based on the schedule. The Examiner further stated that Gile does not disclose each information request having a different destination, but that in the same field of endeavor, Gardell discloses a user accessing a network from several different devices. Therefore, according to the Examiner,

it would have been obvious ... to have incorporated requesting network information to different devices [sic] in a system for transmitting network information as taught by Gardell into a system and method for allowing a user to select and download audio/visual tracks from the Internet of Gile because it would allow more flexible ways of accessing networks, particularly the Web.

C. The February 14, 2003 Response To Applicant's Arguments Eloquenty Evidences The Improper Treatment Of Applicant's Claims

The Board has ample reason to sustain this appeal even before it examines the language of the claims and the scope of the technical disclosures of the references. The impropriety of the

2. Because the claims refer to information requests having different destinations, they were amended to make clear that the user profile defines a schedule of two or more information requests having different destinations.

examination of Applicant's claims is conclusively established by the response in the February 14, 2003 office action to Applicant's November 27, 2002 arguments. The alleged evidence as to a suggestion in the art to modify Gile in the manner proposed is that

Gile specifically discloses in col. 5, line 65 - col. 6, line 5 that various changes and modifications could be made without departing from the invention. Therefore, seeing that audio/video tracks being downloaded from the www (120) over an Internet connection (122), would not be limited to just one device (destination). [sic]³ Gile would have led to Gardell in which data information is delivered to multiple devices (different destinations). (Final rejection, paragraph 17(a).)

It is common for patent applicants to include boilerplate paragraphs in their patent applications stating that although specific embodiments of an invention have been disclosed, variations may no doubt occur to those skilled in the art without departing from the spirit of the invention. Such boilerplate contains no technical disclosure whatsoever; its purpose is to provide a basis for later arguing, in the event that a patent is issued and a suit is filed for infringement of the patent, that the claims, even if not literally infringed, are entitled to broader coverage under the doctrine of equivalents.

Regardless of the effectiveness of such boilerplate language in expanding claim coverage beyond literal claim language under the doctrine of equivalents in infringement litigation, such boilerplate language has no lawful bearing on an obviousness determination. The key question in an obviousness inquiry is whether there is a suggestion in the record art of the desirability, and thus the obviousness, of modifying a prior art reference or combining prior art references *to form the claimed invention*. The stated ground of rejection did not rely on any disclosure in Gile, or

3. Although there are many reasons adequate to sustain this appeal on the merits, Applicant wishes to preserve the argument that statements of grounds of rejection, like an applicant's specification and claims, must be set forth in such full, clear, concise, and exact terms as to enable a member of the public to ascertain unambiguously the basis of the Patent Office's action. The statement of the ground of rejection in this case does not do so.

elsewhere, that *specific* modifications might be made to the Gile system; it relied solely on the general statement in Gile that the Gile invention might be modified.

That rationale is erroneous. On that analysis, any patent directed to a specific invention which states that the invention is modifiable would make any possible modification obvious to a person of ordinary skill in any art. The final rejection treats the modification boilerplate as turning Gile into a "wild card" reference that can be arbitrarily designated, at the whim of an Examiner, to suggest any modification at all.

The February 14, 2003 office action asserts that because Gile discloses that modifications are possible, Gile would have led to Gardell's alleged disclosure of information delivery to multiple destinations. It is preposterous to suggest that Gile's bare disclosure of modifiability would lead a person of ordinary skill in the art *directly* to the *particular* reference on which the Examiner is relying to fill in the missing pieces of Gile and form the claimed invention. The reliance on that proposition clearly shows impermissible hindsight use of Applicant's disclosure as a roadmap for reconstruction of the invention.

Another aspect of the response to Applicant's arguments that demonstrates the impropriety of the rejection is the reference to unspecified but allegedly well-known art while questioning the scope of the invention:

It is also clear to the examiner that delivery of data or multimedia information to multiple devices is extremely well known. Is applicant claiming that the novelty of their invention related to the well-known teaching of delivering information over the Internet to multiple devices? [sic] (Final rejection, paragraph 17(a).)

These matters were not raised in the August 27, 2002 office action, although they could have been. A final rejection is not the appropriate place to raise questions as to the scope of the claims, or to first assert the existence of allegedly well-known prior art. The claims were not

rejected based on lack of novelty, or on indefiniteness grounds relating to the different information requests having different destinations. The MPEP sets forth particular requirements for finality of an action, including:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. ... [t]he invention as disclosed and claimed *should be thoroughly searched in the first action and the references fully applied* ...

(MPEP 706.07(a); emphasis added) The rejection should not have been made final if a clear issue had not been developed as to the meaning of the claims and without citation to the allegedly well-known prior art pertinent to them. The Examiner chose to make the rejection final, and the above-quoted response to Applicant's arguments is an improper attempt to support the rejection without citing or applying any art. It further shows that the improper procedure of first deciding that the invention is unpatentable, and then looking around for arguments to bolster the decision, was followed.

Set forth below are reasons why the rejection was improper on the merits.

D. The Examiner's Modification of Gile Is Improper

The Examiner's suggested modification of Gile ignores the nature and purpose of the Gile system. The Gile system downloads multimedia tracks automatically on a user-specified schedule in order to create a user-customized compact disc ("CD"). (E.g., Giles abstract.) Although downloading multimedia tracks and writing them to a CD can be done manually by a user in an on-line session, the problem addressed by Gile is that doing so can be inconvenient:

Depending on the size and format of the multimedia track, the bandwidth of the user's Internet connection, and the amount of traffic on the Internet at the time of download, the process required in visiting a service site, downloading a requested track, and listening to or watching the downloaded track may be time-consuming and/or inconvenient. (Gile col. 1 lines 37-43.)

To avoid the possibly time-consuming and inconvenient task of manually accessing and downloading multimedia tracks in an on-line session and writing them to a CD, the Gile system permits these activities to be performed automatically according to a user-defined schedule so that a CD containing the selected multimedia tracks will be ready at the desired ready time. (Gile col. 1 lines 53-63; col. 3 lines 10-27.) The tracks on the CD thus created can be retrieved later at the user's convenience. (Ibid.)

Thus, the purpose of the Gile system is to conveniently obtain multimedia tracks and aggregate them on a physical data storage medium associated with the user's computer so that when it is convenient for the user to access the multimedia tracks, they may be accessed quickly and easily from the local data storage medium, rather than from the network in an on-line session. In the language of the claims of the present invention, the only "destination" to which a "set of information" can be delivered to effect the purpose of the Gile system is the writable CD drive of the user's computer. Modification of Gile to deliver sets of information to different destinations would defeat the purpose of Gile's invention to provide a CD available at a scheduled time from which the user's selected multimedia tracks can be retrieved at the user's convenience. Modification of Gile to meet the invention of claims 1 and 13 would therefore be improper. E.g., In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

E. Gardell Does Not Suggest Modifying Gile To Form The Claimed Invention

Moreover, even if it were proper to modify Gile, modifying Gile in view of the teachings of Gardell would not render the invention of claims 1 and 13 obvious. Gardell simply does not suggest directing different sets of information, obtained automatically from scheduled downloads, to different destinations. All that Gardell discloses in connection with the destination of downloaded information is a system in which a user can access the Internet manually from one

of several different Internet access devices, and in which the destination for information downloaded in any particular session is the Internet access device from which the user is conducting that session.

The Gardell invention is primarily "apparatus and methods for accessing of a network using a variety of types of apparatus, such as a set top box for a television or a computer." (Gardell col. 1 lines 13-17.) These differing types of Internet access device have differing technical capabilities: "[f]or example, a computer is most suitable for viewing Web sites with a high text content. Web sites with a high motion video or sound content, however, are best visited from an entertainment console. A Web site that provides telephone directory services might be best visited from a screen phone." (Gardell col. 1 lines 46-54.) Thus, in a secondary aspect, the Gardell system "also captures session information in a centralized location during accessing, thus allowing a user integrated access to the network across multiple sessions." (Gardell col. 1 lines 16-20.)

What Gardell means by "integrated access to the network across multiple sessions" is the ability of a user to start a session from one Internet access device, terminate that session, and start another session from a second Internet access device, with information obtained during the first session being available in the second session. This feature of the Gardell system results from maintaining session information in an Internet server, rather than in a browser in the user's Internet access device as is typically done, and is described in the portions of Gardell cited by the Examiner, especially at col. 6 line 50 - col. 8 line 19. The utility disclosed by Gardell for this arrangement arises when a user who is conducting a manual on-line session from a first Internet access device, accesses Internet content that is more preferably presented using the display capabilities of a second Internet access device:

An example illustrates a use of the architecture shown in FIG. 7. A subscriber might browse the Web from their television 758 and locate a page that is interesting. The page, however, contains dense text and links to down-loadable files, which may not be best viewed on television 758. The subscriber uses a remote control input device and STB 752 to create a new bookmark, which is captured in the user service information (FIG. 3) by Internet server 714. The next day, the user may access the Web from subscriber computer 746. The bookmark defined the previous evening is available, allowing the user to read and down-load the materials using computer 746. The preferred embodiment also allows a subscriber's electronic mail (FIG. 3) to be available in a completely consistent form at both the computer 746 and the television 758.

Alternatively, a subscriber using a Web browser on computer 746 may locate a site that is better viewed from television 758. This might be a site with attached MPEG data, a page with a large number of different colors, or simply a page with layout hints optimized for television 758. The subscriber sets a bookmark so that the site can be easily found from television 758. Similar integration may be used for a variety of other technologies, such as voice mail, PDA's, and other communication or content devices. (Gardell at col. 7 lines 31-56.)

The Gardell system is a *manual* system. Its "integrated access to the network across multiple sessions" is effected *manually*. The Gardell system relies upon the user to determine, in a first session conducted from a first Internet access device, that particular content might better be viewed from a different Internet access device, to manually bookmark the location of the content, to terminate the first session, to initiate a second session from a second Internet access device, and to manually find and invoke the stored bookmark in order to re-access the location and have its content "delivered" to the second Internet access device. Gardell is not directed to automatic systems and suggests nothing at all regarding destinations for automatically-obtained information.

Gardell suggests nothing at all regarding *specifying*, for an information request, the destination for delivery of information obtained in response to the request. Gardell teaches only that the destination for delivery of information obtained in response to a request is the Internet access device from which the request was sent. Gardell contains no disclosure or suggestion of

sending retrieved content *other than* to the particular Internet access device a user presently happens to be using during the ordinary on-line, real-time, manually conducted Internet access session in which the user accesses the content. The fact that, in such an on-line, real-time, manually-conducted session, a user might access particular content using bookmarks stored in a previous session, which might have been conducted from a different Internet access device, is entirely irrelevant to Applicant's invention. Gardell may not properly be cited as teaching the feature claimed in claims 1 and 13 of automatically delivering sets of information prepared in response to information requests in a schedule to corresponding destinations in the schedule. Accordingly, it is respectfully submitted that claims 1 and 13 are not unpatentable over Gile in view of Gardell.

Because Gile is not a reference which under 35 U.S.C. § 103 might be modified to produce the invention defined in the claims, and Gardell is not a reference which discloses or suggests those modifications to Gile which would be required if such modification were proper, it is respectfully submitted that all claims are patentable over these references.

F. The Benefit Of The Invention Does Not Suggest Modifying Gile To Form It

The Examiner states that it would have been obvious to modify Gile to incorporate requesting delivery of network information to different devices "because it would allow more flexible ways of accessing networks, particularly the Web." (E.g., paragraphs 4 and 17(b) of the February 14, 2003 office action.) This is merely a statement of the benefits achieved by the invention. If the prior art does not contain even a suggestion of the specific modifications that are needed to be made to the teachings of the prior art to yield the claimed invention, then a rejection on the grounds of obviousness based solely on the advantages provided by that claimed invention is an improper use of hindsight. See, e.g., In re Fritch, 972 F.2d 1260, 1266,


23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992) The Examiner cites no suggestion in the prior art of the benefit that would be obtained by modifying Gile to incorporate requesting delivery of network information to different devices, and so the only source for the Examiner's assertion is Applicant's disclosure. Therefore, reliance on the benefit of modifying Gile to form the claimed invention is impermissible hindsight.

G. Conclusion

For the foregoing reasons, Applicant requests that this appeal be sustained, that the rejection be reversed, and that the application be allowed.

Respectfully submitted,

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APPENDIX

THE CLAIMS INVOLVED IN THE APPEAL

1. A method for providing information over a computer network, comprising the steps of:
 - (a) providing for a user profile, wherein the user profile defines a schedule of two or more information requests, each information request having a corresponding destination, including a first information request having a corresponding first destination and a second information request having a corresponding second destination different from the first destination;
 - (b) preparing a set of information corresponding to each information request; and
 - (c) automatically delivering each set of information to the corresponding destination at a time based on the schedule.
2. The invention of claim 1, wherein the corresponding destination for a particular information request is an Internet radio and the corresponding set of information has an audio format for rendering on the Internet radio.
3. The invention of claim 1, wherein the corresponding destination for a particular information request is an Internet television and the corresponding set of information has an audio/video format for rendering on the Internet television.
4. The invention of claim 1, wherein the corresponding destination for a particular information request is a personal computer and the corresponding set of information has at least one of an audio, a video, and a text format for rendering on the personal computer.
5. The invention of claim 1, wherein step (a) further comprises the step of presenting a computer-based interface for a user to define the user profile.
6. The invention of claim 1, wherein step (c) further comprises the step of initiating a connection to the corresponding destination over the computer network at the time based on the schedule.
8. The invention of claim 1, wherein each of the first and second destinations is an Internet radio, an Internet television, or a personal computer.
9. The invention of claim 1, wherein the sets of information for the first and second information requests are automatically delivered to the corresponding first and second destinations at different times based on the schedule.
10. The invention of claim 1, wherein step (b) further comprises the step of converting

format of the set of information based on the corresponding destination.

11. The invention of claim 1, wherein step (b) further comprises the step of gathering the set of information from two or more different network-based sources of information.

12. The invention of claim 1, further comprising the step of providing a user with flexibility to modify the information requests or the corresponding destination or the schedule.

13. A server for providing information over a computer network, comprising:

(a) an input port configured to receive a user profile, wherein the user profile defines a schedule of two or more information requests, each information request having a corresponding destination, including a first information request having a corresponding first destination and a second information request having a corresponding second destination different from the first destination;

(b) a processor configured to prepare a set of information corresponding to each information request; and

(c) an output port configured to automatically deliver each set of information to the corresponding destination at a time based on the schedule.

14. The invention of claim 13, wherein the corresponding destination for a particular information request is an Internet radio and the corresponding set of information has an audio format for rendering on the Internet radio.

15. The invention of claim 13, wherein the corresponding destination for a particular information request is an Internet television and the corresponding set of information has an audio/video format for rendering on the Internet television.

16. The invention of claim 13, wherein the corresponding destination for a particular information request is a personal computer and the corresponding set of information has at least one of an audio, a video, and a text format for rendering on the personal computer.

17. The invention of claim 13, wherein the input port is configured to present a computer-based interface for a user to define the user profile.

18. The invention of claim 13, wherein the output port is configured to initiate a connection to the corresponding destination over the computer network at the time based on the schedule.

20. The invention of claim 13, wherein each of the first and second destinations is an

Internet radio, an Internet television, or a personal computer.

21. The invention of claim 20, wherein the sets of information for the first and second information requests are automatically delivered to the corresponding first and second destinations at different times based on the schedule.

22. The invention of claim 13, wherein the processor is configured to convert format of the set of information based on the corresponding destination.

23. The invention of claim 13, wherein the processor is configured to gather the set of information from two or more different network-based sources of information.

24. The invention of claim 13, the server is configured to provide user flexibility to modify the information requests or the corresponding destination or the schedule.